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MAILED

JAN 03 2011

OFFICE OF PETITIONS

In re Patent No. 6,609,975 :
Issue Date: 26 August, 2003 :
Application No. 08/918,944 : DECISION ON PETITION
Filed: 25 August, 1997 :
Attorney Docket No. 099302 :

This is a decision on the petition filed on 15 April, 2010, properly treated as a petition under 37 C.F.R. §1.378(b)¹ requesting acceptance of payment of a maintenance fee for the above-referenced patent as having been delayed due to unavoidable delay.

NOTES:

Petitioner submitted a revocation/power of attorney, but failed to submit the required supporting certificate pursuant to 37 C.F.R. §3.73(b).

Thus, as of this writing

- *The power of attorney has not been accepted or entered; and*
- *The address of record (as set forth above) is different from that on the petition.*

A courtesy copy of this decision is being forwarded to the address on the petition, however, until a complete and proper revocation/power of attorney with the required supporting certificate pursuant to 37 C.F.R. §3.73(b), all correspondence will be directed to the correspondence of record (as set forth above).

Petitioner is reminded to include all filings herein complete information with narrative and documentary support.

¹ A grantable petition to accept a delayed maintenance fee payment under 37 C.F.R. §1.378(b) must include

(1) the required maintenance fee set forth in §1.20(e) through (g);

(2) the surcharge set forth in §1.20(l)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The petition pursuant to 37 C.F.R. §1.378(b) is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 C.F.R. §1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision.

No extension of this 2-month time limit can be granted under 37 C.F.R. §1.136(a) or (b).

A petition for reconsideration **must** be accompanied by the petition fee of \$400.00 as set forth in 37 C.F.R. §1.17(f).

The petition for reconsideration **shall** include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, the Director will undertake no further reconsideration or review of the matter.

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

A petition to accept the delayed payment of a maintenance fee under 35 USC §41(c) and 37 C.F.R. §1.378(b) must be accompanied by:

- (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely;*
- (2) payment of the appropriate maintenance fee, unless previously submitted; and*
- (3) payment of the surcharge set forth in 37 C.F.R. §1.20(i)(1).*

The instant petition fails to satisfy requirement (1), listed/described above.

BACKGROUND

Patent No. 6,609,975 (the '975 patent) issued on 26 August, 2003. The first maintenance fee could have been paid during the period from 26 August, 2006, through midnight 26 February, 2007, or, with a surcharge, during the period from 27 February, 2007, through midnight 26 August, 2007. Accordingly, the patent expired after midnight 26 August, 2007, for failure to pay timely the first maintenance fee.

The instant petition (with fee) pursuant to 37 C.F.R. §1.378(b) was filed on 15 April, 2010.

STATUTE AND REGULATION

The grant of authority at 35 U.S.C. §41(c)(1) provides that:

The Director may accept the payment of any maintenance fee required by subsection (b) of this section...after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

The regulations 37 C.F.R. §1.378(b)(3) thus set forth that any petition to accept delayed payment of a maintenance fee must include:

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. (Emphasis supplied.)

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty of candor and duty to disclose.²

OPINION

The Director may accept late payment of the maintenance fee under 35 U.S.C. §41(c) and 37 C.F.R. §1.378(b) if the delay is shown to the satisfaction of the Director to have been “unavoidable.”³

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. §133 because 35 U.S.C. §41(c)(1) uses the identical language, i.e., “unavoidable” delay.⁴ Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.⁵ In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.”⁶

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner’s duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(Petitioner obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

³ 35 U.S.C. §41(c)(1).

⁴ *Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm’r Pat. 1988)).

⁵ *Ex parte Pratt*, 1887 Dec. Comm’r Pat. 31, 32-33 (Comm’r Pat. 1887) (the term “unavoidable” “is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful man in relation to their most important business”); *In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); *Ex parte Henrich*, 1913 Dec. Comm’r Pat. 139, 141 (Comm’r Pat. 1913).

⁶ *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

Finally, a petition to revive an application or reinstate a patent as abandoned or expired due to unavoidable delay cannot be granted where a Petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁷

Petitioner's Contentions
as to Unavoidable Delay

Petitioner Thomas H. Jackson (Reg. No. 29,808 (Petitioner)) sought relief on behalf of patentee/assignee Tony Cranford/Ten Stix Gaming Inc., pursuant to the regulations at 37 C.F.R. §1.378, averring unavoidable delay.

As noted above, Patent No. 6,609,975 (the 975 patent) issued on 26 August, 2003. The first maintenance fee could have been paid during the period from 26 August, 2006, through midnight 26 February, 2007, or, with a surcharge, during the period from 27 February, 2007, through midnight 26 August, 2007. Accordingly, the patent expired after midnight 26 August, 2007, for failure to pay timely the first maintenance fee.

The entirety of the showing in support of the petition appears to be in the form of two (2) Emails, a copy of a Notice of Expiration, and statements from:

- Tony Cranford (Mr. Cranford)—three (3) pages—averred to be the President of Ten Stix Gaming Inc.,⁸ that:

Mr. Cranford, being unaware of the maintenance fee due [on or before 26 August, 2007] until February of 2010, Mr. Cranford, as soon as reasonably possible after learning of the expiration of the '975 patent, [submitted the] Petition.

Mr. Cranford and his former partner [and co-inventor Thomas Sawyer], Mr. Sawyer, have not communicated on business matters since 2006. ***Mr. Cranford upon personal recollection and upon information and belief, never learned of any maintenance fee being due from his ex-partner, Mr. Sawyer (sic).⁹

⁷ *Haines v. Quigg*, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

⁸ The 15 April, 2010, Petition indicates, at page 1, that the assignee Ten Stix Inc. is located at "12252 West Chenango Drive, Morrison, CO 80465 (formerly known as TEN STIX, INC. of 3101 Riverside Dr. Idaho Springs, C) 80452)"—which information raises a question of whether or not Ten Stix Inc conveyed change of address information to former Counsel at Arent Fox and/or Computer Patent Annuities/CPA Global and/or any other responsible party.

⁹ The 15 April, 2010, Petition, at pages 2, , 4; the Cranford Declaration at pages 2 and 3. Notably, the Cranford Declaration, at page 2, also states that he "relocated Ten Stix to Morrison, CO, from Idaho Springs, CO, and then to Lakewood, CO. and back to Morrison, CO." Again, there is no indication that Mr. Cranford and/ or Ten Stix Inc notified Computer Patent Annuities/CPA Global or anyone else of any and/or all of these moves and so provide a timely notice of change of address.

- Thomas Jackson (Mr. Jackson/Counsel) —three (3) pages—averred to be with the PCT Law Group and “responsible for Ten Stix patent application preparation and prosecution since approximately November of 2008,” that:

Mr. Jackson *** received an e-mail from Mr. Cranford requesting the status of the ‘975 patent and, learning of the expiration of the ‘975 patent for failure to pay the 3½ year maintenance fee when due, reported the same by e-mail to Mr. Cranford. *** Upon his return to the office after an unprecedented snow storm in the Washington, DC, area in February 2010, Mr. Jackson conducted a thorough search of the PCT Law Group Offices (sic) to locate any business records comprising any correspondence or patent file related to the prosecution of the above-identified application resulting in issuance of US 6,609,975 or to its expiration. Mr. Jackson found no such file. Mr. Jackson requested Mr. Cranford to diligently search for any business records of Ten Stix directed to the ‘975 patent. *** Mr. Jackson further inquired of Wilburn Chesser, Esq., of Arent Fox LLP if any such file was in the possession of Arent Fox LLP. ***

Moreover, Mr. Jackson, on February 16, 2010, made inquiry on behalf of Mr. Cranford and Ten Stix of CPA Global (formerly Computer Patent Annuities) with Mr. Cranford’s permission, to determine if CPA Global could recover any business records related to the payment or lack thereof of a maintenance fee in re US Patent No. 6,609,975. *** Ms. Jennifer Lopez [(Ms. Lopez)] of CPA Global replied by e-mail of February 23, 2010. Her e-mail indicates that CPA transmitted four renewal notices to Ten Stix and, never receiving a reply, allowed the patent to lapse. The dates on the renewal notices are 22 Sep (sic) 2006; 22 Nov 2006; 22 Mar 2007 and 21 July 2007.¹⁰ ¹¹

- Wilburn Chesser (Mr. Chesser) —three (3) pages—averred to be with Arent Fox LLP, who stated that:

... he has undertaken a thorough search of Arent Fox LLP records for correspondence or other documents related to the payment or lack thereof of a maintenance fee in re US Patent No. 6,609,975 and has located no such records. *** Mr. Chesser’s recollection that on or about August 10, 2006, Mr. Chesser was requested by Mr. Cranford to transfer all Ten Stix files to James Bindseil, Esq., then at the law firm of Loew Hauptman Ham & Berner. ***

Mr. Wilburn Chesser further states in his Affidavit that, upon the issuance of US Patent No. 6,609,975, in the August of 2003 time frame, it was the practice of the

¹⁰ The 15 April, 2010, Petition, at page 4; the Jackson Declaration at pages 2 and 3.

¹¹ The 15 April, 2010, Petition, at page 4; the Jackson Declaration at pages 2 and 3—and, notably, there is no indication of the address and/or addresses to which Computer Patent Annuities/CPA Global sent the notices.

firm of Arent Fox Kintner Plokin & Kahn PLLC, with whom Mr. Chesser was then associated, to request that maintenance fee responsibilities be handled by Computer Patent Annuities (later CPA Global), of Alexandria, Virginia. *** Mr. Chesser states in his Affidavit that to the best of his personal recollection, he had no knowledge of the expiration of US Patent No. 6,609,975 until learning of the expiration from Mr. Jackson's inquiry. *** Mr. Chesser's request to Computer Patent Annuities of Alexandria, VA, to assume maintenance fee responsibilities for the '975 patent is evidence by a Notice of Patent Expiration issued September 24, 2007, and address to Computer Patent Annuities.¹²

- James Bindseil (Mr. Bindseil) —two (2) pages—averred to be formerly of the law firm of Lowe Hauptman Ham & Berner (LHHB), later the law firm of Amin Turocy & Calvin, now Turocy & Watson (the Turocy Firm), that:

... he conducted an investigation including inquiries of [LHHB firm and the Turocy Firm for any files related to the '975 patent]. Mr. Bindseil testifies that neither firm has any files. *** Mr. Bindseil's recollection is that he initially received any (sic) Ten Stix file at approximately the 3.5 year maintenance fee due date or some time after August of 2006. *** Also, it is Mr. Bindseil's recollection and upon information and belief that the law firm of [LHHB] did not send out any letters to Mr. Cranford or Ten Stix for paying the first maintenance fee during the maintenance fee window calculated above. **** Mr. Bindseil understood from Mr. Chesser that LHHB was not responsible for payment. It was Mr. Bindseil's recollection that Computer Patent Annuities was responsible for handling annuity correspondence with Ten Stix.¹³

The E-mail between Mr. Jackson and:

- Mr. Cranford (1 page); and
- Ms. Lopez (5 pages)

are included. As noted in footnote, there is no indication as to the address/addresses used by Computer Patent Annuities/ CPA Global in its attempts to communicate with Mr. Cranford/Ten Stix. Moreover, there is no indication that Mr. Cranford/Ten Stix notified Mr. Chesser and/or Mr. Bindseil, and/or their respective firms, and/or any other heretofore unnamed/unidentified Counsel and/or Computer Patent Annuities/CPA Global of any change of address from Morrison to Idaho Springs, to Lakewood to Morrison, Colorado.

¹² The 15 April, 2010, Petition, at pages 5-6; the Chesser Declaration at pages 1 and 2.

¹³ The 15 April, 2010, Petition, at pages 6-7; the Bindseil Declaration at pages 1 and 2.

The showing indicates that—rather than unavoidable delay—the patentee/assignee Mr. Cranford/Ten Stix apparently ignored at least:

- the content of the patent document (setting forth the maintenance fee requirements) on issue; and
- the need to inform/advise Mr. Chesser and Mr. Bindseil and/or their respective firms and/or Computer Patent Annuities/CPA Global of Mr. Cranford's/Ten Stix's several moves from Morrison to Idaho Springs to Lakewood and to Morrison, Colorado.

Moreover, Petitioner's showings/statements/declarations suggest that the patentee/assignee Mr. Cranford/Ten Stix made it difficult if not impossible for Mr. Chesser and Mr. Bindseil and/or their respective firms and/or Computer Patent Annuities/CPA Global, to contact Mr. Cranford/Ten Stix for an extended period of time.

Such facts do not suggest diligence—at least a level of diligence as required herein—on the part of those who were supposed to attend to this matter—to wit: the patentee/assignee Mr. Cranford/Ten Stix.

The provisions of 35 U.S.C. §41(c)(1) do not require an affirmative finding that the delay was avoidable, but only an explanation as to why the Petitioner has failed to carry his or her burden to establish that the delay was unavoidable.¹⁴ The provisions of 35 U.S.C. §133 do not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing.

Petitioner is reminded that it is the patentee's/assignee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.¹⁵

This the patentee/assignee has/have not done.

At bottom, the question is one of diligence.¹⁶

Because 35 U.S.C. § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.¹⁷ That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35

¹⁴ See *Commissariat A. L'Energie Atomique v. Watson*, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

¹⁵ See *Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991)(table), cert. denied, 502 U.S. 1075 (1992); *Ray v. Lehman*, *supra*.

¹⁶ See: *Changes to Patent Practice and Procedure, Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997). See also: *Ray v. Lehman*, *supra*.

¹⁷ *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788.

U.S.C. § 41(c) and 37 C.F.R. §1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the third/last maintenance fee for this patent.¹⁸ There are three periods to be considered during the evaluation of a petition under 37 C.F.R. §1.378(b):

- (1) The delay in reply that originally resulted in expiration;
- (2) The delay in filing an initial petition pursuant to §1.378(b) to reinstate the patent; and
- (3) The delay in filing a grantable petition pursuant to §1.378(b) to reinstate the patent.¹⁹

At the outset and as of this writing, the showing is not persuasive with regards to the nature of the delay in reply that originally resulted in expiration or as to the filing of the initial petition (Items 1 and 2), which are the only periods pertinent at this time.

Petitioner must provide documentary foundations in support of a showing of unavoidable delay.

Thus, at this writing the statements presented in/with the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 C.F.R. §1.378(b).

A showing of diligence in matters before the Office is essential to support a finding of unavoidable delay herein.²⁰ There is no "sliding scale" based upon the priority given to this maintaining this patent in force, or more diligently seeking reinstatement, *vis-a-vis* other matters by Petitioner. The issue is solely whether the maintenance, or reinstatement, of the patent at issue was actually conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business.

At this writing the record fails to adequately evidence the exercise of due care and diligence observed by prudent and careful persons, in relation to their most important business, which is necessary to establish unavoidable delay.²¹

The record at this writing does not provide a clear showing that reasonable steps were taken to ensure timely payment of the maintenance fee. In fact, the record indicates that no steps were taken by Patentee(s) and/or Assignee to ensure timely payment of the maintenance fee.

The provisions of 37 C.F.R. §1.378(b) preclude acceptance of the delayed payment of the maintenance fee due to unavoidable delay. The regulations at 37 C.F.R. §1.378(b)(3) state that any petition to accept delayed payment of a maintenance fee must include:

¹⁸ *Id.*

¹⁹ See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

²⁰ See *Futures Technology, Ltd. v. Quigg*, 684 F. Supp. 430, 431, 7 USPQ2d 1588 (E.D. Va. 1988)(applicant's diligent inquiry into the status of the application is required to show unavoidable delay); *Douglas v. Manbeck*, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (even representation by counsel does not relieve the applicant from his obligation to exercise diligence before the USPTO; applicant's lack of diligence extending two and one half years overcame and superseded any omissions by his counsel).

²¹ *Pratt, supra.*

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

In any future filing, this showing should include, but is not limited to, docket records, tickler reports, and file jacket entries for this application, and documents regarding the alleged cause of the delay and copies of any documents referred to in Petitioner's statement as to the cause of the unavoidable delay are required. All the causes which contributed to the failure to timely pay the maintenance fee must be presented and supported with appropriate evidence.²² (In general, a Petitioner should identify the party(ies) responsible for making the payment: A showing must be made (with supporting documents) outlining the efforts made to ensure timely payment of the maintenance fee--including scheduling and calendaring information, appointment of an individual with the authority and responsibility to pay the fee, and detailing of the causes for a failure in that process.)

Thus, as of this writing, the Office is unable to grant the relief sought.

In summary, the showing of record has been considered, but does not rise to the level of unavoidable delay. Rather, the showing of record is of possible a lack of diligence. (See: http://www.uspto.gov/web/offices/pac/mpep/documents/2500_2590.htm#sect2590)

CONCLUSION

For the reasons stated above, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. §41(c)(1) and 37 C.F.R. §1.378(b).

It is noted that the fees paid by Petitioner incorrectly included a \$65.00 payment that was not applicable and, thus, inappropriate -- the fee is being refunded by credit card. Should Petitioner later find that the fee was not refunded, Petitioner may submit a request for refund to the Office of Finance and include therewith a copy of this decision.

Accordingly, the petition under 37 C.F.R. §1.378(b) is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

²² The showing must also enumerate the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Statements from all persons who contributed to the delay are also required.


Patent No. 6,609,975
Application No. 08/918,944

By Mail: Mail Stop PETITION
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Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By facsimile: (571) 273-8306
Attn: Office of Petitions

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2²³) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
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²³ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of Petitioners or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.